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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,581	10/20/2003	Xavier Blin	231036US0	2539

22850	7590	05/17/2007
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.		
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ALEXANDRIA, VA 22314		

EXAMINER	
KANTAMNENI, SHOBHA	

ART UNIT	PAPER NUMBER
1617	

NOTIFICATION DATE	DELIVERY MODE
05/17/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/687,581

Applicant(s)

BLIN ET AL.

Examiner

Shobha Kantamneni

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 18-25 is/are withdrawn from consideration.
- 5) ☒ Claim(s) NONE is/are allowed.
- 6) ☒ Claim(s) 1-17 and 26-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date  
:05/04/06;10/14/05;10/04/05;10/20/03.

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### **DETAILED ACTION**

Claims 1 to 30 are pending in this application

#### ***Election/Restrictions***

Claims 18-25 are withdrawn from consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions.

Applicant's election with traverse of the claims of Group I, namely claims 1-15 (in part), 16-17, 26-30 (in part), drawn to a composition comprising in a cosmetically acceptable medium at least one oily phase and at least one photochromic organic dye of formula (I) or (II) in the reply filed on 02/12/2007, is acknowledged. The traversal is on the grounds that a search and/or examining for all groups would not pose an undue burden on the Office. This argument has been considered, but not found persuasive because even though the searches for the two Groups may be overlapping, there is no reason to believe that the searches would be co-extensive. In searching Group I, the Examiner will be focusing on the patentability of the photochromic organic dye and the oils as in claims 16-17, and not the silicone oils of Groups II. It is pointed out that silicone oils are distinct from animal or plant oils, and come under different classification. Further, in searching Groups I-II, the Examiner will be focusing on the patentability of the products and not the process. Conversely, in searching Group III, the Examiner will be focusing on the patentability of the process and not the product itself. Accordingly, a search for all groups would pose an undue burden on the Office.

The requirement is still deemed proper and is therefore made FINAL.

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Claims 1-17, and 26-30 are examined herein as they read on the elected invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-9, 11-17, 26-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The location of R7, and R'2 is unclear according to formula (I) and formula (II). The examiner has interpreted the drawing to indicate that R7 can be at any open position on the core structure.

Regarding Claims 14-15, it is unclear what applicant is claiming by "apolar" oil, and the specification did not provide the definition of the term. The examiner is interpreting this to be non-polar oil.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-17, 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lagrange (US 6,123,952, PTO-892), in view of Clark et al. (WO 99/31081, PTO-1449).

Lagrange discloses a cosmetic composition comprising organic photochromic compounds in cosmetically acceptable oily phase. LaGrange discloses the organic photochromic compounds are compounds which have the property of changing color when they are irradiated with a light source and then regaining their initial color when the irradiation stops (column 1, lines 43-46). It is taught that the use of organic photochromic compounds in make-up or hair compositions gives novel coloring effects. See column 1, lines 6-10, lines 39-42. The composition can be in any cosmetically acceptable form, such as in the form of a lotion, suspension, dispersion or solution in aqueous-alcoholic or solvent medium, which may be multi-phasic; in the form of a gel, a mousse, a spray, an oil-in-water, water-in-oil or multiple emulsion; in the form of a free, compact or cast powder; in the form of an anhydrous solid or paste (column 3, lines 46-54). The photo chromic coloring agent is present in the amount of 0.05-30% by weight (column 6, lines 27-28). The composition also contains a cosmetically acceptable medium (column 6, lines 34-35). A fatty phase may be present comprising oils of animals, plants, mineral or synthetic origin, waxes of animal, plant, mineral, or synthetic origin, pasty fatty substances, gums, or mixtures thereof. See column 6, lines 46-52. Volatile oils may also be present, hydrocarbon based oils, such as isoparaffins, and in particular isododecane and fluoro oils. Non-volatile oils can also be used which can be polar or non-polar and include oils of animal, plant

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(such as castor oil), or mineral origin, and in particular animal or plant oils formed from fatty acid esters of polyols, in particular liquid triglycerides,. See column 6, line 54-column 7, lines 64. A face cream comprising oils in an amount of 20 % by weight is disclosed. See column 12, EXAMPLE 1. The cosmetic compositions therein are in the form of face cream, hair lotion, eyeshadow. See column 16-18, claims, 11-12, 20-21. The composition can also comprise a particulate phase, which can comprise pigments and/or pearlescent agents and/or fillers usually used in cosmetic compositions (column 10, lines 65-68). The fillers, which can be present, are in a proportion of from 0 to 30% by weight (column 11, lines 34-35). Pigments include white or colored, inorganic or organic particles intended to color or opacify the composition (column 11, lines 1-2), iridescent particles which reflect light (column 11, lines 8-9), and lakes and dyes (column 11 ,lines 16-25).

Lagrange does not disclose the employment of the particular instant photochromic organic dyes in the cosmetic composition therein.

Clark et al. disclose photochromic dyes, naphthopyrans of formula (I) or (II) which read on instant photochromic organic dyes. See abstract; pages 12-15, Examples 1-18; pages 25-27, claims 1-6. It is also taught that the photochromic dyes therein may be used to impart different colors to a solution, matrix or host material. See page 6, paragraph 2 from bottom.

It would have been obvious to a person of ordinary skill in the art at the time of invention to employ the photochromic compounds taught by Clark et al. in a cosmetic composition because Lagrange teaches that cosmetic compositions comprise photochromic organic dyes. One of ordinary skill in the art at the time of

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invention would have been motivated to employ the photochromic organic dyes taught by Clark et al. in a cosmetic composition with reasonable expectation of obtaining a make-up or hair compositions with desirable coloring effects.

Furthermore, as the combined teachings of Lagrange and Clark et al., renders the claimed composition obvious, the property of such a claimed composition will also be rendered obvious by the prior art teachings, since the properties, namely the "mean solubility parameter  $\delta_a$  according to the Hansen solubility space, at 25 °C, of greater than or equal to  $5.0 \text{ (J/cm}^3)^{1/2}$ " as in claims 12, 13, and "mean solubility parameter  $\delta_a$  according to the Hansen solubility space, at 25 °C, of less than  $5.0 \text{ (J/cm}^3)^{1/2}$ " as in claims 14-15, are the properties of the oils, and the properties are inseparable, since Lagrange teaches the same oils in the cosmetic composition therein. Further, the recitation "having a  $\Delta E$  value of greater than or equal to 5" is the property of the composition, and as the combined teachings of Clark et al., and Lagrange renders the claimed composition obvious, the property of such a claimed composition will also be rendered obvious by the prior art teachings as discussed above. Therefore, if the prior art teaches the composition or renders the composition obvious, then the properties are also taught or rendered obvious by the prior art. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990.) See MPEP 2112.01.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude"



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granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-17, 26-30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9, 24-32 of Application 10/687645. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both drawn to substantially overlapping compositions for cosmetic benefits.

Thus, the compositions, in the application '645 and in the instant application are seen to be substantially overlapping. Therefore, the instant claims 1-17, and 26-30 are seen to be obvious over the claims 1-9, and 24-32 application 10/687645.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Claims 1-17, 26-30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12, 29-37 of Application 10/687632. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both drawn to substantially overlapping compositions for cosmetic benefits.

Thus, the compositions, in the application '632 and in the instant application are seen to be substantially overlapping. Therefore, the instant claims 1-17, and 26-30 are seen to be obvious over the claims 1-12, 29-37 of application 10/687632.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Prior Art Made of Record:

WO 98/45281

US 6,627,121

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shobha Kantamneni whose telephone number is 571-272-2930. The examiner can normally be reached on Monday-Tuesday, Thursday-Friday, 8am-4pm.

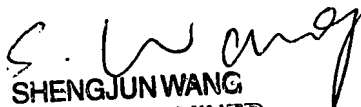
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, Ph.D can be reached on 571-272-

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0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shobha Kantamneni, Ph.D  
Patent Examiner  
Art Unit 1617

  
SHENGJUN WANG  
PRIMARY EXAMINER